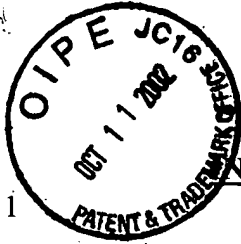


#3



Docket No.
694231/0011
JJD:JFD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: McFaddin et al.

Group Art Unit: 2152

Application No.: 10/077,282

Examiner: Not Yet Assigned

Filed: February 14, 2002

For: **METHOD AND SYSTEM FOR DELIVERING A COMPOSITE
INFORMATION STREAM OVER A COMPUTER NETWORK**

Date: October 10, 2002

Commissioner for Patents
Washington, D.C. 20231

**DECLARATION OF JAMES J. DECARLO IN SUPPORT OF
PETITION TO ACCEPT THE SIGNATURE OF TWO JOINT INVENTORS
ON BEHALF OF THEMSELVES AND ON BEHALF OF A JOINT INVENTOR
WHO REFUSES TO JOIN IN THE APPLICATION (37 CFR § 1.47(a))**

I, JAMES J. DECARLO, hereby declare that:

1. I am a citizen of the United States, a registered patent attorney at the law firm of Stroock & Stroock & Lavan LLP, having offices at 180 Maiden Lane, New York, NY 10038, and attorney for signing applicants and Assignee Yahoo!, Inc., a corporation having offices at 701 First Ave., Sunnyvale, CA 94089, hereinafter referred to as "Yahoo!."

2. I make this Declaration to provide facts in support of a Petition To Accept The Signature Of Two Joint Inventors On Behalf Of Themselves And On Behalf Of A Joint Inventor Who Refuses To Join In The Application (37 CFR § 1.47(a)). The two signing joint inventors are Justin P. Madison and Michael D. Bigby. The joint inventor who refuses to join in the application is James E. McFaddin.

3. This Declaration is being made based on my first-hand knowledge of the facts recited herein.

4. The last-known residence address of Mr. McFaddin is 3021 Filberton, Dallas, Texas 75229.

5. The last-known mailing address of Mr. McFaddin is P.O. Box 781212, Dallas, Texas 75378.

6. I first met with Mr. McFaddin on December 5, 2000. On that date, Mr. McFaddin was informed that I was Yahoo!'s patent attorney. At that meeting, we discussed the function of a software application, which function formed the basis of the subject patent application.

7. A copy of an employment agreement between Yahoo! and Mr. McFaddin, signed by Mr. McFaddin, is attached as Exhibit 1.

8. In the employment agreement, Mr. McFaddin indicated that he had invented no inventions prior to his signing of the employment agreement.

9. Mr. McFaddin's employment at Yahoo! was subsequently terminated.

10. On May 16, 2001, after Mr. McFaddin's employment with Yahoo! ended, U.S. Patent Application Ser. No. 09/859,562, the parent case to the present application, was filed. The patent application was filed with an unexecuted Declaration, and listed Mr. McFaddin as a joint inventor, along with Mr. Bhargav Gade.

11. The United States Patent and Trademark Office issued a Notice To File Missing Parts—Filing Date Granted, for U.S. Patent Application Ser. No. 09/859,562, on July 16, 2001.

12. In an attempt to obtain a signed Declaration, I forwarded a copy of the application, as well as a Declaration for signature, to Mr. McFaddin on July 31, 2001. A copy of the application and Declaration sent to Mr. McFaddin is attached as Exhibit 2.

13. On or about August 7, 2001, I learned for the first time that Mr. McFaddin, based on the specification and claims of U.S. Patent Application Ser. No. 09/859,562, believed himself to be the sole inventor of the claimed invention. Mr. McFaddin also informed me that contrary to the information in his signed employment agreement, he believed that he had conceived of the claimed invention prior to his employment at Yahoo!.

14. Mr. McFaddin further informed me that he would not sign a Declaration for U.S. Patent Application Ser. No. 09/859,562, because he believed that he was the sole inventor of the claimed subject matter, and because he believed that he had conceived of the claimed invention prior to his employment with Yahoo!. Mr. McFaddin, however, did not offer any documents providing evidence in support of his belief. Copies of e-mail messages providing further proof of Mr. McFaddin's refusal to execute the application are attached as Exhibit 3.

15. After learning of Mr. McFaddin's assertions, I conducted a further investigation at Yahoo!. I had telephonic and personal conversations with other employees at Yahoo!., including Mr. Justin P. Madison, Mr. Michael D. Bigby and Mr. Bhargav Gade. During those conversations, I discussed the concept of inventorship, as it pertains to the United States Patent Laws and Rules. After review of the application, including the specification, drawings and claims, by me and the aforementioned Yahoo! employees, the proper inventorship for the application was determined. Specifically, it was determined that Mr. McFaddin was a joint inventor with Mr. Madison and Mr. Bigby, and that Bhargav Gade, originally named as co-inventor, was in fact not a co-inventor. Based upon my investigation, I believe that inventorship is properly placed with Mr. McFaddin, Mr. Madison and Mr. Bigby. The present application is a continuation of U.S. Patent Application Ser. No. 09/859,562, and comprises the same specification, drawings and claims.

16. Specifically, during the pendency of U.S. Patent Application Ser. No. 09/859,562, on February 14, 2002, applicants filed the present patent application, U.S. Patent

Application Ser. No. 10/077,282. U.S. Patent Application No. Ser. 10/077,282 claimed priority to U.S. Patent Application Ser. No. 09/859,562, and contained a specification, drawings and set of claims that was identical to those of the earlier application. This was done in effort to continue efforts to secure Mr. McFaddin's cooperation.

17. In the intervening months after Mr. McFaddin first refused to sign, Mr. McFaddin retained counsel, Arthur Navarro, Esq., of Godwin Gruber, P.C. of Dallas Texas. I continued for months to seek Mr. McFaddin's cooperation through his counsel, however, Mr. Navarro advised me that Mr. McFaddin would not sign an application that did not name Mr. McFaddin as a sole inventor, and that Mr. McFaddin was requesting a six-figure payment from Yahoo!. I was once again advised by telephone, in August of 2002, with finality, that Mr. McFaddin would not cooperate. Nonetheless, a copy of the application and Declaration for the present application was sent to Mr. Navarro.

18. I am aware that the United States Patent and Trademark Office issued a Notice To File Missing Parts—Filing Date Granted, on March 13, 2002, in U.S. Patent Application Ser. No. 10/077,282.

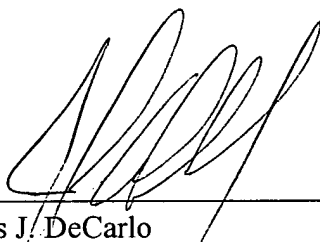
19. To date I have not received a signed Declaration from Mr. McFaddin, nor do I believe I ever will.

20. Since Mr. McFaddin is refusing to execute the Declaration, I will not receive a signed Declaration from Mr. McFaddin in time to file them with the United States Patent and Trademark office in a timely response to the outstanding Notice to File Missing Parts, or at any time.

21. Accordingly, I respectfully request that the Commissioner allow the Petition To Accept The Signature Of Two Joint Inventors On Behalf Of Themselves And On Behalf Of A Joint Inventor Who Refuses To Join In The Application (37 CFR § 1.47(a)).

I hereby declare that all statements made herein of my own knowledge are true; and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that willful false statements may jeopardize the validity of the application, any patent issuing thereon or any patent to which this verified statement was directed.

Dated: OCT. 9, 2002


James J. DeCarlo